Supreme Court, U. S.
FILED
FEB 18 1976
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-110

BERNARD A. SAKRAIDA,
Petitioner,

versus

AG PRO, INC.,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

REPLY BRIEF FOR PETITIONER

JAMES F. HULSE and
STEPHEN B. TATEM, JR.
11-D El Paso National Bank Bldg.
El Paso, Texas 79901

R. DOUGLAS LYON
LYON & LYON
9th Floor
800 Wilshire Blvd.
Los Angeles, California 90017

Attorneys for Petitioner

Of Counsel:

SCOTT, HULSE, MARSHALL & FEUILLE
11-D El Paso National Bank Bldg.
El Paso, Texas 79901

WILSON - EPES PRINTING CO., INC. - RE 7-6002 - WASHINGTON, D. C. 20001

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REPLY BRIEF FOR PETITIONER

To the Honorable Justices of the Supreme Court of the United States:

This Reply Brief is in two parts—one of which deals with certain erroneous implications of Respondent's Brief and the other of which answers the erroneous legal contentions raised in the Amicus Curiae Brief of the Bar Association of the District of Columbia (hereinafter "D.C. Bar Brief").

REPLY TO RESPONDENT'S BRIEF

Respondent contends that Petitioner "combined" his evidence of prior art and evidence of the level of skill of an ordinary person in the art together in his Brief, to imply that the evidence "had all been before the trial court at the time of the trial on the merits" (i.e. September 13, 1971 before Judge Guinn) (Respondent's Brief 3). Respondent contends there was absolutely "no evidence" (a) to support Judge Guinn's finding that "Dairy Establishment" was not novel, and did not meet the test of nonobviousness, or (b) Judge Wood's finding that Petitioner exercised due diligence in discovering Herb Meyer's flush operation at Mission Dairy. Respondent also contends that the water flush concept that Herb Meyer implemented at the Mission Dairy is irrelevant to a determination of the validity of "Dairy Establishment" because the beginning of milking operations at Mission Dairy did not predate the Gribble and Bennett invention, and, therefore, Mission Dairy cannot be considered as "prior art".

Petitioner rejects any inference of confusing the evidence before J. Guinn and the evidence before Judge Wood. Moreover, evidence sufficient to disqualify the claimed subject matter from patentability was before the Patent Office which failed to apply a proper legal test in its assessment of Respondent's "Dairy Establishment" in the context of the relevant prior art background.

Judge Guinn Found "Dairy Establishment" Lacked Novelty And Held It To Be Obvious

Judge Guinn specifically referred to the prior art patents of McCornack (Supp. A. 55-74), Holz [Sic Hoeiz] (Supp. A. 97-100), Ingraham (Supp. A. 84-87), Kreutzer (Supp. A. 27-44, 45-54), Bogert (Supp. A. 75-83), Luks (Supp. A. 18-26), and the statements of the patent examiner's opinion in initially refusing to issue a patent (Petitioner's Brief, p. 13-15). He used them as a basis for his opinion that "Dairy Establishment" was not a valid patent because the concept lacked novelty, and the small differences from the prior art were within the level of ordinary skill—hence obvious under 35 U.S.C. § 103 as a matter of law. (Findings of Fact 4, 5, and 6; A. 51-2).

Judge Guinn concluded in part by stating, to-wit:

> "All that the Plaintiff has done is to construct several elements known in the prior art in a sequence known in a dairy barn. This may be relevant to commercial success, but not to invention." (A. 53).

The Fifth Circuit (474 F.2d 167) repudiated these findings of Judge Guinn, to state in part, to-wit:

> "None of the prior art references proffered by defendant in this case, independently or combined, suggest that plaintiff's novel flooding mechanism was an obvious advancement in the art." (Petition, p. 17a).

This Fifth Circuit summation of the prior art patents of record before Judge Guinn on September 13, 1971, is erroneous. Petitioner need cite only a portion of the specifications appearing in the McCornack patent (Exhibit 7, A. 95), and the Bogert patent (Exhibit 8, A. 96) to demonstrate dispositively that the Fifth Circuit erred in saying that "none of the prior art references . . . suggest that plaintiff's novel flooding mechanism was an obvious advancement in the art" (Petition, p. 17a).

Respondent admits all elements of this combination patent are old, and the only question is, does the positioning of a water tank at the upper end of the dairy barn floor, with a simple drop gate in one side of the tank as a means of releasing the water, constitute an invention, or promote the Progress of Science and useful

Arts. The evidence before J. Guinn showed the use of collected waters to flow down a barn floor and, by a flushing action, clean it, was not new or novel, and did not meet the test of nonobviousness.

Not only did the affidavits of W. C. Fairbank and Archie C. Sharp (A. 34, 41) relate to the collection of water in a pool, i.e., in a canal, ditch or stream by use of a weir, and directing the flow of water thus accumulated down the barn floor at dairies at Weed, Lodi and Bishop, in California, but the McCornack and Bogert patents, which were before J. Guinn, each covered a system of collecting water at the floor level, and a means of releasing it suddenly onto the barn floor so that, by gravity, a quantity of water flushed the manure off the floor and into a receptacle or outlet for it.

McCornack's patent, entitled "Dairy Plant", has as one of its comprehensive objects the idea "to save labor" (both as to the milking and removal of manure operation), and "for disposing of the manure and utilizing the valuable constituents thereof" (Supp. A. 67). McCornack states in his specifications that "Dairy Plant" uses water pipes so arranged that they discharge water against and "flush" the surfaces of the sanitary shields *and* also "flush" the milking benches and gutters (Supp. A. 68, Column 1, Lines 22-31). The term "flush" as defined by Webster, means to wash out, or discharge with a sudden, rapid flow of water, to flow suddenly, or to flood. In McCornack, each individual shield could be flushed separately, but preferably the shields are flushed simultaneously by means of a "common valve." It was also provided that the cow lanes, and their manure gutters were sprayed and flushed from lateral pipes in the same way (Supp. A. 68, Column 1, Lines 26-31). By a system of "flushing" the stables, the milking room, and the cow lanes, both the solid and liquid values of the manure are carried into a catch basin (Supp. A. 68, Column 2, Lines 47-54).

McCornack is to the effect that sanitary conditions could be maintained and accomplished (with ease and certainty) because of a water main located under the stalls controlled by a "valve" operated with a foot pedal for convenient operation by an operator. Water flowing from the pipe "flushed" off the *surface* and carried all refuse into a "gutter" from which it flowed "by gravity" to a suitable outlet. Figures 23, 24, and 25 show the complete layout of such a "Dairy Plant" which encompassed the manure drainage system (Supp. A. 72, Column 1, Lines 39-69). The description in the patent states that all of the *surfaces and gutters* drained towards the lanes at the front of the stables which are also suitably guttered and provided with water pipes if necessary so that all the manure may be "flushed", *with or without the aid of brooms*, towards the front of the stable (Supp. A 72, Column 2, Lines 55-61).

McCornack specifically states that "all of these areas and passageways" are "flushed with wash water" which carries or assists in carrying all of the manure, both solid and liquid, into the storage basin (Supp. A. 73, Column 1, Lines 1-3). In Claim 10, McCornack states that not only the sanitary shields, but also the "floor" of the stalls are "flushed" clean [1] of manure (Supp. A. 74 Column 2, Lines 14-16).

Bogert's patent, which in part is titled "Apparatus for Cleaning" barns and stables (Supp. A. 78), teaches the idea of providing the "means" for automatically cleaning the manure and urine gutter at the rear of the stalls by progressive action of a fluid cleaning medium (Supp. A. 78, Column 1, Lines 1-5). It should be noted

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[1] When referring to the physical appearance of the finished result following the flushing operation, Petitioner assumes that Respondent's choice of the adjective "immaculate" (Respondent's Brief, p. 15, 25) is simply sales puffing and not a representation or warranty.

that the Bogert barn design positions the cows in such a manner that manure falls into a "gutter" that runs the length of the row of stalls, as opposed to a situation where the manure falls directly on the *floor* of the barn. Therefore, the gutter is flushed or flooded to remove manure, as opposed to flushing the floor as is done in "Dairy Establishment."

Figure 3 depicts the "fluid cleaning medium supply tank" (Supp. A. 78, Column 1, Lines 17-19). It is submitted that in substance a "fluid cleaning medium supply tank" is the same *means* as a storage tank, or water tank, that can be used to house or dam water as referred to in "Dairy Establishment." The tank collects water in a "pool", just as recited in Respondent's patent. Bogert specifies that the floors or bottoms of the gutters are inclined downward to the left so that the liquified or semiliquified matter will pass by gravity from the ends of the gutters into a common reservoir, or tank, where it may be stored for future use (Supp. A. 78, Column 2, Lines 21-7). In order to remove the manure, Bogert taught the idea of releasing a "predetermined amount" of water at various points throughout the length of the gutter at different velocities (Supp. A. 78, Column 2, Lines 35-6). Bogert also uses the term "flush" as descriptive of his idea of removing manure from the inside of a gutter (Supp. A. 78, Column 2, Line 39).[2]

Bogert further discloses a "cap valve" which can be pivoted on its hinge located on the bottom of the "fluid cleaning medium supply tank", which valve is lifted upward to release the water (Supp. A. 79, Column 1, Lines 53-6). The flushing action is described by Bogert in his specification as follows, to-wit:

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[2] In Footnote 2 (Petition, p. 15a), the Fifth Circuit refers to Mr. Huber's scrutinization of the prior art references, and specifically with respect to the Bogert patent, advances the contention that the patent utilizes "a sprinkler system."

> ". . . upon opening the cap valve the volume of water in the reservoir passing through the passage into the chamber will tend to force the water through the conduits and their lateral branches with great velocity, thereby entering the gutters with maximum pressure which will move the matter therein toward the outlets . . . after the water has passed over the partitions it will travel through the conduits and branches and flush the gutters." (Supp. A. 79, Column 2, Lines 10-15). See also Column 2, Lines 49-72.

In Claim 1, Bogert refers to a "common gutter" that is opened throughout its length into which the manure would fall. Several outlets enter into the gutter in order to convey a "fluid medium" for flushing the gutter (Supp. A. 80, Column 2). Claim 4 positions the "fluid medium reservoir" *above* and at one end of the walk, for conveying the fluid medium to flush the gutter clean (Supp. A. 81, Column 1). See also Claims 5, 6, 15, 16, and 21.

"Dairy Establishment", *like* McCornack's and Bogert's idea, is an "automatic-hydraulic" device for the removal of waste products from the floor of a dairy barn (Respondent's Brief, p. 5). Each teaches a manually operated device which releases stored water into a gutter, or onto a floor to allow the natural propensity of water to act as a cleaning agent as it flows downhill. Regardless of how water may be released to flow downhill, the "function" of the water in each case is the same, i.e. as a *means* to clean or remove manure from a floor. The fact that the volume of water released on any given time, is larger, or that the water may flow faster because of the slope or length of the floor, affects only the "efficiency" of the result, and is not a change in substance, idea, novelty, or obviousness of the concept that water will clean as the natural result of its force as it flows downhill. To assert that the Gribble and Bennett

idea "taught the use of a controlled volume of water dispersed as a sheet of water", and that this concept was not disclosed by the prior art as shown by the dairies at Weed, Lodi and Bishop, and also as set out in McCornack and Bogert—and even described in Greek mythology—is at variance with the facts.

To quote Mr. Fairbank, on the concept of a "sheet form of water", the record is as follows, to-wit:

> "To use a sheet form is a hell of a poor term. Pardon me, I would not want it on the record, but the sheet form, what is a sheet of water How is that defined? That is—that is one of those unfortunate words.
>
> Well, to me when I turn a fire hose down a floor to hose a floor off, it fans out and makes basically a sheet of—sheet flow of water, or if you have a drop gate 20 feet wide, a drop that—that means a drop more or less level set, so I think it's kind of a rather ambiguous, if not nondescript, term—
>
> . . . could lead to some misunderstanding." (A. 165-6)

Judge Guinn's findings to the effect that the component parts of "Dairy Establishment" are each individually old (this fact has been admitted by Respondent), that they are not novel, and that the combination of them in this patent is not novel was fully supported by the two prior art references set forth above. These findings were not clearly erroneous, and hence the Court of Appeals for the Fifth Circuit was not authorized *to substitute* its judgment for that of Judge Guinn. Rule 52 F.R.C.P. These fact findings, moreover, were fully consistent with those that the Patent Office made based on the *same* prior art references and for that reason, too, the Fifth Circuit should have left them undisturbed. Judge Guinn's *legal* conclusion of obviousness was supported by these fact findings and should have been affirmed.

Patent Office Failed To Apply The Correct Legal Test In Determining Patentability

Petitioner has set forth specifically in his Brief (p. 13-15) the pertinent quotes from each negative opinion rendered by the patent examiner that passed on "Dairy Establishment" *before* the application was finally approved, in order to emphasize that the old and obvious nature of "Dairy Establishment" was clearly revealed by the prior art of record, but an incorrect legal test was applied. Since the basic layout of a Grade A modern dairy barn, the concept of "flushing" either the gutter or floor of a barn to remove urine or manure, the idea that a "flush" is accomplished by releasing a varying amount of water from a stored position, and the utilization of the liquid slurry as a fertilizer, were *each* long known in the prior art and were hence elements freely available to ordinarily skilled mechanics or farmers for routine use, it is relevant to probe the basis on which the Patent Office distinguished the prior art from the concept set forth in "Dairy Establishment."

Appendix G to Petitioner's Brief provides the answer. It shows that the Patent Office, having determined the "scope and content of the prior art" and ascertained the small "differences" between that art and "Dairy Establishment", then failed to assess the "ordinary level of skill in the art" and instead, advised the Respondent to recite those differences in its claims. Thus, the Examiner suggested:

> "A claim such as 19 may be amended to avoid the prior art by including the dump tanks and dam positively and their respective location with the different areas and their cooperation so as to clean the different areas with the wash water and waste being

collected in one tank for a desired purpose. Desired dependent claims may be added to depend from amended Claim 19." (Petitioner's Brief, p. 3a, Appendix G, R. 55).

In other words, the *Patent Office* suggested that *if* the claim were recast to recite any small difference it would be allowed. No effort was made to apply the full legal test of § 103 of obviousness. Had the effort been made, the conclusion is inescapable that common sense dictates that a "dump tank" or "dam" must be located *positively* at the uphill level, or above the floor or gutter upon which water was to be released, and that there is nothing inventive about this.

McCornack, as well as Bogert, housed the stored water in a position that allowed it to flow downhill towards a drain or gutter. Natural law or physics teaches that it is impossible to "flush" water uphill, or to naturally release water to flow into drains that are higher than the point from where the water is released. The fact that the water may "cooperate" with the areas of the floor so as to be efficient as a flush system or with a valve, stopper, weir dam, sluice gate or the like to flow out upon opening thereof, is simply a matter of *ordinary* design or construction, and not a novel or nonobvious change from what had been known before. Implicit in the prior art epitomized by McCornack and Bogert is the fact that the design, shape, contour, and slope of the gutter and conduits is such that they allow the water to "cooperate" with the deposit of manure in order to be an effective or efficient water flush system. Likewise implicit in these typical prior art teachings is the cooperation between liquid, such as water, and any form of stopper that holds it within or releases it from a container.

In short, while the Patent Office correctly determined "the scope and content of the prior art" and "the difference between the prior art and the . . . [alleged *Gribble-Bennett* invention]" as *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966) counsels, it not only failed to resolve "the level of ordinary skill in the pertinent art" (ibid), but advised Respondent to specifically claim the "differences" and issued a patent covering them *even though* they are "exceedingly small and quite non-technical differences in a device [a dairy barn] which was old in the art", *Graham, supra*, 383 U.S. at 36. Indeed, "at the latest, those differences were rendered apparent in . . . [1941] by the appearance of the . . . [Bogert] patent . . ." (ibid).[3]

Nor was attention given in the Patent Office to the circumstances that the rewritten claims recite a mere "conjunction or concert of known elements . . . wanting in any unusual or surprising consequences from the unification of the elements . . ." and that these old elements perform no "additional or different function in the combination than they perform out of it." *Great A & P Tea Co.* vs. *Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950).[4]

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[3] In this case, analogously to *Calmar* vs. *Cook*, adjudicated with *Graham*, 383 U.S. at 35,

"The problems confronting . . . [Gribble and Bennett and the dairy industry, assuming they may properly be characterized as "problems"] were not . . . [milk or dairy industry] problems; they were mechanical . . . [cleaning] problems."

The sheet of water released in the dairy barn, however dramatic Respondent's movie may suggest its effect there to be, does not differ patentably or conceptually from the Bogert or McCornack teachings, nor is there any functional distinction between that sheet of water and the sheet of water released for cleaning purposes in *any* milieu, such as, e.g., one tips over a pail of water on a raised porch or deck so as to sweep away all refuse in the path of the water as it flows to the surface of the land or water below.

[4] Thus focussing on *Graham's* basic inquiries,

a) the "scope and content of the prior art" shows each element to be old.

[Footnote continued on page 12]

Had either of these imperatives been properly considered and given effect, the Gribble and Bennett patent *a fortiori* COULD NOT have issued. Because the Patent Office thus *failed* to follow the proper *legal* test of patentability under 35 U.S.C. § 103, this patent necessarily has *no* cognizable presumption of validity under 35 U.S.C. § 282.

There Being No Presumption Of Validity, Judge Guinn's Correct Legal Opinion On Summary Judgment Should Have Been Affirmed

Judge Guinn correctly applied *Anderson's Black Rock, Inc.* vs. *Pavement Salvage Company, Inc.*, 396 U.S. 57 (1969) to hold the Gribble and Bennett patent *invalid as a matter of law* under 35 U.S.C. § 103[5] based in part on the "correspondence between the Patent Office and Gribble and Bennett's attorney which was written during the time the patent application was pending" (Pet. 26a) and which reflected the Patent Office fact findings relative, *inter alia*, to the exemplary Bogert and McCornack prior art and showed that an improper legal test was the basis for issuing the patent.

The Fifth Circuit reversal of this correct—and dispositive—holding not only forced an unnecessary, judicially wasteful, trial but opened the door for Respondent's introduction at the trial of irrelevant evidence on "secondary considerations" (Pet. 27a-28a) and hence led to the Fifth Circuit error which is at the heart of this proceeding.

[4] [Continued]

b) the sole "difference" is that the elements are combined, since each performs no different function in the combination than outside it.

c) the "ordinary level of skill in the art" is necessarily capable of thus associating and disassociating old elements; if it were otherwise, patents would be a mechanism for subtracting old knowledge from the public domain and removing resources already freely available to artisans in derogation of the Constitution. See *Graham, supra*, 383 U.S. at 6, and the Texas Farmers Union Brief at 9-17, especially pages 10-12.

[5] Since *Black Rock* reaffirms, reemphasizes and rests upon *Graham, supra*, he necessarily also applied *Graham* in so holding.

Petitioner submits that lower courts *should* be able to dispose summarily of patent validity in instances where, as here, the Patent Office record clearly demonstrates that issuance of the patent resulted from a focal error of law on the part of the Office. The Fifth Circuit holding fosters continued Patent Office errors of law and issuance of further legally invalid patents, to say nothing of unnecessary and inappropriate trials in the lower federal courts.

Judge Wood's Finding That Diligence Was Shown In Discovering Herbert Meyer[6]

The trial court found as a fact "that the names of witnesses and the nature of their testimony was discovered purely by chance by the Defendant [Petitioner here] at a meeting in January of 1973 by [sic with] Mr. Herbert G. Meyer." (A. 175) The Fifth Circuit did not repudiate this finding but inferred from other facts of record that Petitioner could have learned about Mission Dairy *per se* from sources other than Mr. Meyer (Pet. 3a-4a).

Respondent now urges, without any record evidence to support the argument, that this Court should *assume* that Meyer himself and his relationship to Mission Dairy,

[6] Respondent's jurisdictional argument (Respondent's Brief 39-42) was first raised in *this* Court by Motion, which has already been denied. The argument is in any event misplaced. Petitioner's "Motion" as originally brought in the Fifth Circuit was in the form of a Petition for Rehearing rather than a Motion under Rule 60(b)(2). That Petition was granted only as to the newly discovered evidence point, in the exercise of the Appellate Court's "broad authority under 28 U.S.C. § 2106" (Pet. 8a).

neither of which were known to Petitioner before January, 1973, could have been discovered earlier if Petitioner had been diligent. Manifestly Respondent's argument is an exercise in the very "hindsight"—or, as the Fifth Circuit would say, "intuitive analysis distorted by the invention's simplicity and retrospective self-evidence"—that Petitioner is accused of exercising in contending that "Dairy Establishment" is obvious under 35 U.S.C. § 103.

Respondent repeatedly asserts that W. C. Fairbank told Petitioner's counsel in 1969 the Mission Dairy had a flush system like Respondent's. This is based upon Mr. Fairbank's reconstruction of what he thought he should have told Petitioner's counsel, but the written evidence is to the contrary. On October 8, 1969, Mr. Fairbank wrote counsel, with a revised copy of his affidavit, and said, "I can only cite prior use of flowing water across barn floors for the purpose of flushing away manure—*not the use of a tilt bucket or a dam for impounding the water on the floor.*" (emphasis added) (A. 173) And in his affidavit dated October 13, 1969, Par. (i) he referred only to Weed, Lodi and Bishop, California, and made no mention of the Mission Dairy (A. 34, 36).

The Relevancy Of Mission Dairy As Prior Art Or Evidence Of Ordinary Skill In The Art

Preliminarily, Petitioner stresses that the prior art evidence as it stood before the second Fifth Circuit decision (Pet. 9a-22a), of which Bogert and McCornack are exemplary, affords an entirely adequate basis on which to decide this case in his favor *as a matter of law*. The Court should nevertheless recognize that the subsequently presented newly discovered evidence, including that relating to Mission Dairy, is relevant, admissible and cognizable here. Respondent's counsel has

conceded that the "flush system" used at Mission Dairy is substantially the same as what is disclosed by "Dairy Establishment" (A. 267). Respondents contends, however, that Mission Dairy cannot be considered "prior art" because it was not in operation—i.e. milking—before October 25, 1963 (A. 253), and hence was unavailable more than one year before the November 5, 1963, filing date of Gribble's patent application (A. 27). Respondent conveniently ignores Mr. Meyer's testimony that he filed written plans for the Mission Dairy barn including the flush system with the California Soil Conservation Department, a Government agency under the U.S. Department of Agriculture, as early as January, 1962 (A. 252).[7]

But regardless of whether or not the experience of Herbert Meyer, or the Mission Dairy be regarded as "prior art", this evidence as well as the evidence pertaining to Emil Rovey, Frank Souza, and Chester Whitmore (Petitioner's Brief, pp. 16-19), is certainly relevant and material on the question of the level of ordinary skill in the art as of approximately the time the invention was made. See particularly Petitioner's Exhibit B; A. 209-11, 216. *Concrete Appliances Co.* vs. *Gomery*, 269 U.S. 177, 185 (1925), *All States Plastic Mfg. Co., Inc.* vs. *Weekesser Co., Inc.*, 362 F. Supp. 94, 100-101, (N.D. Ill. 1973) aff'd 506 F.2d 465 (7th Cir. 1974), *Custom Paper Products Co.* vs. *Atlantic Paper Box Co.*, 469 F.2d 178, 180 (1st Cir. 1972), *Reeves Brothers, Inc.* vs. *U.S. Laminating Corp.*, 417 F.2d 869, 872 (2nd Cir. 1969), *International Glass Co.* vs. *United States*, 408 F.2d 395, 404 (Ct. Cls. 1969), *Kay Patents Corp.* vs. *Martin Supply Co.*, 202 F.2d

[7] Petitioner understands that such written plans, filed with this agency are available to interested members of the public as soon as they are filed—and stands ready to so prove if this case should, for any reason, be remanded again.

47, 50-51 (4th Cir. 1953), *Potter Instrument Co., Inc.* vs. *ODEC Computer Systems, Inc.*, 370 F. Supp. 198, 204 (D.R.I. 1974); aff'd 499 F.2d 209 (1st Cir. 1974), *Photon, Inc.* vs. *Harris-Intertype Corp.*, 235 F. Supp. 921, 926 (D. Mass. 1964), aff'd per curiam, 349 F.2d 856 (1st Cir. 1965), *Canadian Ingersoll-Rand Co., Ltd.* vs. *Peterson Products of San Mateo, Inc.*, 223 F. Supp. 803, 812-816 (N.D. Cal. 1963); aff'd 350 F.2d 18 (9th Cir. 1965).

REPLY TO AMICUS BRIEF

The Patent Office failure in *this* case to implement proper legal tests of patentability is by no means unusual; similar failures are routine[8] and led this Court in *Graham* to remark on the "notorious difference between the standards applied by the Patent Office and by the courts", 383 U.S. at 18.[9]

If the Patent Office *were* giving effect to proper legal tests of patentability, much of the "confusion"—real or feigned—adverted to in the D. C. Bar Brief *would not*,

[8] See the Brief Amicus Curiae of the Texas Farmers Union at pp. 17-24.

[9] A remark repeated by the Chief Justice, speaking for the Court, in *Kewanee Oil Co.* vs. *Bicron Corp.*, 416 U.S. 470, 488 (1974) and foreshadowed in 1950 by the concurring opinion in *A & P, supra*, which noted that:

> "The Patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents—gadgets that have no place in the constitutional scheme of advancing scientific knowledge. * * * [Citing Examples]
>
> The patent involved in the present case belongs to this list of incredible patents which the Patent Office has spawned. The fact that a patent as flimsy and spurious as this one has to be brought all the way to this Court to be declared invalid dramatically illustrates how far our patent system frequently departs from the constitutional standards which are supposed to govern." 340 U.S. at 156-158.

and could not exist. Because the Patent Office persists in proliferating patents that do not meet this Court's constitutionally mandated patentability standard which "has remained invariable", *Graham, supra*, 383 U.S. at 19, the lower federal courts are increasingly faced with the need to do the job the Patent Office should have done. Being, as this Court put it in *Graham*, "most ill-fitted to discharge the technological duties cast upon . . . [the judiciary] by patent legislation" (383 U.S. at 36) these lower courts sometimes tend to ignore the "*basic* factual inquiries" defined in *Graham*, 383 U.S. at 17, to focus overearly, overlong and overmuch on the *secondary* considerations "which *may* [*but do not always*] have relevancy" (383 U.S. at 17) in patent cases. *That is just what happened in this case.*

If the Patent Office had properly applied *Graham* and *Anderson's Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) or antecedent Supreme Court precedent embodying the same "invariable" *constitutional* patentability standard, the Gribble and Bennett patent would not have issued. In that event, the evidence of "secondary considerations" which first surfaced below and induced error in the second Fifth Circuit Opinion, would not have been amassed. Similarly, *if* the Patent Office had *properly* addressed itself to *all* of the three "basic factual inquiries" requisite to assessing patentability under 35 U.S.C. 103, rather than only two of them, the patent would necessarily have been refused and the Fifth Circuit would never have become involved.

The Patent Office malaise relative to 35 U.S.C. § 103 results in significant part from precisely the same confused, overly semantic and basically illogical thinking that is exemplified in the D. C. Bar Amicus Brief. This is not surprising, since the Patent Office is daily confronted with those same arguments from patent lawyers who include a preponderance of the members of that

Association's Patent, Trademark and Copyright Section, and from its Appellate Court, the Court of Customs and Patent Appeals ("CCPA").[10]

The baseline fallacy of the Amicus Brief—that *Graham* is inconsistent with *Anderson's Black Rock*—finds no support, direct or inferential, in either opinion and is advanced in the hope of inducing this Court to repudiate its own unanimous and manifestly correct conclusions in *Graham* that the patentability standard is constitutionally ordained and "has remained *invariable* in this Court" (383 U.S. at 19). To make the argument, the amicus D. C. Bar resorts to specious distortions of both *Graham* and *Anderson's Black-Rock*—to wit:

(a) It is argued that *Graham*, by endorsing 35 U.S.C. § 103 as consistent with the invariable constitutional patentability standard and hence a proper exercise of Congressional power, implicitly devitalized all preexisting precedent in which patents were invalidated for "no invention" rather than for "obviousness" and that *Black Rock*, by reviving the pre-1952 terminology to declare a patent invalid because the claimed device was "not an

[10] By reason of geography, the amicus District of Columbia patent lawyers presumably earn most of their livelihood from patent practice before the Patent Office and also engage significantly, albeit to a lesser extent, in prosecuting appeals from the Patent Office before the CCPA and litigating review proceedings of Patent Office decisions in the District of Columbia federal courts.

The D.C. Bar Motion for leave to appear as amicus curiae acknowledges a primary concern with "whether it is worthwhile to file a patent application on a new development or whether a large research expenditure should be made in view of the type of patent protection available" (p. 2a) and, hence, implicitly with maintaining the *status quo* to insure continuing wholesale *availability* of patents from the Patent Office. Despite lip service in the Motion (e.g. p. 3a) and Brief (e.g. p. 5-6) to a *concern* for establishing uniformity in the federal circuits on patentability issues, this association's membership may be presumed to have little direct interest in post-issuance litigation *per se* or in the public consequences of overliberality in granting and enforcing patents.

invention" created a conflict. *This argument reduces to a flimsy semantic ploy.*

(b) It is urged that *Black Rock*, by requiring a combination of old elements to achieve a function transcending the sum of the known functions of the individual parts—i.e. to exhibit "synergism"—departed from the three "basic inquiries" which are the key to resolving obviousness under *Graham*, and established a different, special test of patentability for combination claims. *This argument has no substance; Black Rock itself reemphasizes and reiterates the need to focus on the basic inquiries in every case and illustrates how to do this with "combination" type claims.*

(c) It is contended that *Graham* mandated that evidence of "secondary considerations" be received in every case and that *Black Rock* departed from this mandate by holding such evidence irrelevant to the patentability of a non-synergistic combination. *This argument rests on a false premise; Graham held only that secondary consideration evidence "may have relevancy." Graham itself and Black Rock illustrate instances in which such evidence was irrelevant.*

Because it is of primary importance that the Court neither be misled by these fallacious arguments nor underestimate the impact that they have had upon the Patent Office and, apparently, the Fifth Circuit as well,[11] they are considered in detail hereinafter.

[11] As will be apparent from the discussion *infra*, the federal courts of appeals other than the Fifth Circuit are neither dissonant in, nor particularly confused about the application of *Graham* and *Black Rock*. The D.C. Bar is *wrong* in so implying, e.g., Brief at 5-6. The main divergence in patentability standards—a serious one—is now, as it was in 1966, between the Patent Office and the CCPA on one hand, and the federal courts acting largely under the authority of this Court's unvarying pronouncements, on the other. The Fifth Circuit's aberrancies, while serious, are not typical of the opinions of the latter group.

"Invention-No Invention" vs. "Nonobviousness-Obviousness"—A Semantic Game

The Fifth Circuit in this very case correctly observed that:

> "The Supreme Court held in *Graham* v. *John Deere, supra*, 383 U.S. at 19, 86 S. Ct. 684, that 35 U.S.C. § 103, passed in 1952, merely codified pre-existing requirements and did not relax the standard for patentability. As early as 1851, in *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248, 13 L.Ed. 683, the Supreme Court posited the condition that a patentable invention must evidence more ingenuity and skill than that possessed by an ordinary mechanic acquainted with the business. *That basic standard remains intact. Section 103 simply substitutes the term 'nonobvious' for prior terms such as 'invention' and 'ingenuity' in order to emphasize the objective nature of the test* and avoid the misunderstanding stemming from the controversial phrase 'flash of creative genius' coined in *Cuno Corp.* v. *Automatic Devices Corp.*, 1941, 314 U.S. 84, 62 S. Ct. 37, 86 L.Ed. 58." (Pet. 16a) (Emphasis Added)

In *Graham*, this Court emphasized the correctness and *invariability* of its own constitutionally ordained patentability standard notwithstanding acknowledged contentions "by some of the parties and by several of the amici that the first sentence of § 103 was intended to sweep away judicial precedents and to lower the level of patentability", 383 U.S. at 16.

The Court then specifically reviewed the history of our patent system from the adoption of the Constitution and the first Act of 1790 onward,[12] noted the label " 'invention' as a word of legal art signifying patentable invention", 383 U.S. at 11, as having originated in *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248 (1850) and stressed that:

> "The Hotchkiss formulation, however, lies not in any label, but in its *functional approach to questions of patentability*. In practice, Hotchkiss has required a comparison between the subject matter of the patent or patent application, and the background skill of the calling. It has been from this comparison that patentability was in each case determined." 383 U.S. at 12; (Emphasis Added)

This same functional approach is essentially repeated in *Graham's* statement of § 103's basic factual inquiries; to-wit, "scope and content of the prior art . . . ; differences between the prior art and the claims at issue; and the level of ordinary skill in the art . . ." 383 U.S. at 18.

After explaining that intervening decisions of this Court were fully consistent, including *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941) which "merely rhetorically restated the requirement that the subject matter sought to be patented must be beyond the skill of the calling", 383 U.S. at 15, n. 7, the *Graham* Court reviewed § 103's immediate legislative history and specifically concluded:

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[12] Notably, Thomas Jefferson, one of the administrators of the first Patent Act, not only postulated a patentability standard strikingly similar to the Court's own invariable standard but in 1791 proposed a statutory defense that "The invention is so unimportant and obvious that it ought not to be the subject of an exclusive right." See the Appendix to D.C. Bar Brief at 3a, where the author, Judge Rich, suggests "This proposal was never enacted." Actually, as is apparent from the Texas Farmers Union Brief at 11-12, *all* of the patent statutes in effect from 1790-1793 and 1836-1952 required that an invention could be patented *only* if "*sufficiently* useful and important" to merit an exclusive grant. This Court recognized the direct relationship between that statute and the "invention" label that grew out of *Hotchkiss, inter alia*, in *Reckendorfer* v. *Faber*, 92 U.S. 347 (1876), which in turn enunciates the same "combination" test implemented in *Black Rock* and *A & P*. See Texas Farmers Union Brief, pp. 12-16.

> "We believe that this legislative history as well as other sources [footnote omitted], shows that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the section was intended merely as a codification of judicial precedents embracing the Hotchkiss condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability." 383 U.S. at 17.

In short, *Graham* was careful to hold that Section 103 does *not* repudiate pre-1952 precedent. Any fair reading of its gist is that "nonobviousness" is a *label* just as "invention" is and that *both*, as legal terms of art, have the same meaning in relation to patentability.

It follows that there is *no inconsistency* in *Black Rock's* unanimous holding that "We conclude further that to those skilled in the art the use of the old elements in combination was not an invention by the obvious-non-obvious standard . . ." (396 U.S. at 62-63) or in its various other uses of the term "invention" (396 U.S. at 61, 63).

The D. C. Bar's argument (Brief at 8-12) is purely a semantic game, but its underlying sinister purpose of providing a means for repudiating this Court's relevant pre-1952 decisions has already been accomplished to a significant extent in the Patent Office and the CCPA. See *Rich*, "Change", 2 APLA Q.J. 214 (1974). See also Texas Farmers Union Brief at 17-21.

It is no wonder that chaos and confusion in the patent system are, as a result, on the increase.

The Test For "Combination" Claims Comports With And Is Subservient To *Graham's* Basic Inquiries

Graham's reaffirmation of antecedent case law included specific reaffirmation of *Great A & P Tea Co.* vs. *Supermarket Equipment Corp.*, 340 U.S. 147 (1951), 383 U.S. at 17 and *Cuno*, 383 U.S. at 15, n. 7, and citation with approval of *Lincoln Engineering Co.* vs. *Stewart Warner-Corp.*, 303 U.S. 545 (1938), 383 U.S. at 25. All are "combination" cases. *Graham* also emphasized, 383 U.S. at 6, and *Black Rock* reiterated, 396 U.S. at 61, that, under the Constitution, "* * * Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."

In *Black Rock*—like *Graham*, a unanimous decision—this Court said:

> "Obviousness, as an issue is resolved as follows [under *Graham*]:
>
> 'Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the art resolved.' (383 U.S. at 17)
>
> We admonished that 'strict observance' of those requirements is necessary. Id., at 18 . . ." 396 U.S. at 62.

The alleged special test for combination claims does not depart from *Graham's* basic inquiries but fits precisely under their umbrella. More specifically,

> a) if one examines the "scope and content of the prior art" and finds each element with an explanation of its function to be included therein,[13] and

[13] The suggestion by the D.C. patent lawyers, implicit in the second paragraph of their out-of-context quotation from *Reeves Instrument Corp.* v. *Beckman Instruments, Inc.*, 444 F.2d 263 (9th Cir. 1971), Brief at 25, that prior art elements may not be individually examined in assessing "scope and content of the prior art", but can be looked at only if presented, as a *whole* [combination]", clashes directly with the same lawyers' premise "that a decision on nonobviousness must be made *only* after consideration of *all* rele-

b) one then finds that "the differences between the prior art and the claims at issue" consist *solely* in the fact that the elements have either not previously been combined or have not been combined in the same order, so that the result was wholly foreseeable from the known functions of the individual elements,

c) *a fortiori* the "level of ordinary skill in the art" was sufficient to provide the combination since all elements were known and their functions, which remained unchanged, were understood. *Further* inquiry into level of skill in the art then becomes superfluous.[14]

In short, the combination test is a *subtest* within the *Graham* basic inquiries; it is more limited because the "level of skill" answer is a necessary consequence of the "scope and content" and "differences" answers, but it is not "separate" from *Graham*, as suggested by the D. C. patent lawyers (e.g. Brief at 19). Properly applied, it does *not* hamper, but *fosters*, "development of a consistent body of law under § 103", (Id. at 19), just as it fostered the development of the *invariable* pre-1952 patentability standard which *Graham* found to have been codified in § 103.

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vant evidence" (Brief at 12) since it would disqualify major portions of the prior art evidence in every case.

Moreover, the suggestion is inconsistent with § 103's own language wherein the words "as a whole" clearly modify the *claimed* "subject matter"—i.e., the alleged invention—*not* "the prior art." Thus § 103 calls for an evaluation of "the differences between the subject matter sought to be patented and the prior art" to see if *those differences* "are such that the [allegedly inventive] subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art . . ."

[14] To hold otherwise would countenance the use of patents as a pretext for monopolizing *old knowledge* by cosmetically recombining old elements at will without ever contributing technologically significant information.

Consistency of *Graham's* basic inquiries with *Black Rock's* "combination" subtest is further demonstrated by the fact that if inquiry into "differences" reveals a result unpredictable from the known functions of the individual old elements—i.e., "synergistic" or exceeding their sum—then the "level of ordinary skill in the art" must be assessed on the basis of further evidence.[15]

Viewing the matter in this light, moreover, it is clear that the "combination" rationale is applicable to every invention if one feels impelled, like the D. C. patent lawyers, to view every invention as a combination of old elements (Brief at 22-24). Using that approach, the chemical compound at issue in *Commissioner* v. *Deutsche Gold-und Silber-Scheideanstalt Vormals Roessler*, 397 F.2d 656 (D. C. Cir. 1968) cited in D. C. Bar Brief at 4, n. 5, and at 30, was a combination of old chemical elements, but the "differences" were such that the combination was synergistic in that the function of the combination was wholly *un*predictable from the known properties of the individual elements.[16] The same can be said of "Dr. Seaborg's invention of the transuranium elements" (D. C. Bar Brief at 24).[17] Even the Fourdrinier machine

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[15] It follows that "synergism" as a legal term of art, as used in *Black Rock* will characterize *all* patentable combination inventions, but *not all* claims defining synergistic combinations will be patentable. Thus, for example, the synergistic result may have been attained previously or may be within the level of ordinary skill because of other pre-existing knowledge and hence be unpatentable. *Black Rock* accordingly does *not* substitute synergism for nonobviousness as the D.C. Bar charges (Brief at 20, n. 35a).

[16] Importantly, chemical compounds *always* display "synergism" because chemical elements are *always* transformed when they react, so that each loses its separate identity and known functions in the "combination." Whether a chemical compound is *patentable* is accordingly never dependent upon the "combination" subtest but must be determined from the answers to the "basic factual inquiries" as then beamed upon the compound *per se*. See also Note 15, *supra*.

[17] *Reeves Instrument Co.* vs. *Beckman Instruments, Inc.*—*supra* n. 13, is presented in an erroneous light by the D.C. Bar Brief

improvement patent adjudicated in *Eibel Process Co.* vs. *Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923) cited in D. C. Bar Brief at 31, exhibited synergism and hence was capable of supporting a valid patent.

To sum up, where "differences" reside only in putting together what the art knew how to use separately with a merely additive, wholly predictable result, there is obviousness under § 103 and *per se* unpatentability,—and that has been the law since at least 1790. Only when the "differences" include the presence of a new, *non*-additive, *un*predictable result, may nonobviousness and hence patentability be found—and then *only if* the "basic inquiries" otherwise provide a justification for the finding.[18]

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at 25-26, through carefully tailored quotation. Actually, *Reeves* properly recognized that ". . . the Court in *Black Rock* reaffirmed the position it had previously taken in *Graham* v. *John Deere Co.*, 383 U.S. 1, to make clear that the crucial question in determining obviousness is whether the differences between the subject matter sought to be patented, as a whole, and the prior art are obvious to a man of ordinary skill in the art." 444 F.2d at 271.

The later Ninth Circuit Opinion in *Rex Chainbelt, Inc.* vs. *Harco Products, Inc.*, 512 F.2d 993, 999-1000 (1975) explains that Reeves comports with *A & P* and *Black Rock*.

To the extent *Reeves* suggests that strict application of the principle of *per se* unpatentability of aggregations of old elements, each of which performs an old and well known function in combined form, will soon disqualify "virtually every new mechanical or electrical device" from being patented, *Graham* provides the answer, 383 U.S. at 19. As the Court there noted. "Technology . . . has advanced and with remarkable rapidity in the last 50 years . . . The ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an even-handed application to require that those persons granted the benefit of the patent monopoly be charged with an awareness of those changed conditions." *In other words*, various disciplines, such as mechanics, *may* well be subsumed entirely within the ordinary level of skill in the art at some point—and when that happens, patents *will* be precluded in those fields.

[18] The D.C. patent lawyers are *wrong* in asserting that the Court in *United States* v. *Adams*, 383 U.S. 39 (1966) found "that each element of the battery [every one of which was old] functioned

"Secondary Considerations" Are An Unreliable Last Resort In Evaluating Obviousness

In *Graham* this Court was careful to point out that

> "Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., *might* be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries *may* have relevancy . . . ." 383 U.S. at 17, (Emphasis Added)
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> * * * * * * * *
>
> "Such inquiries [into secondary considerations] *may* lend a helping hand to the judiciary . . . . They may also serve to 'guard against slipping into hindsight' . . . ." 383 U.S. at 35, (Emphasis Added)

The patent lawyers seek to distort the word "secondary" and the words "may" and "might" in an effort to put in this Court's mouth words it never said, thereby elevating secondary considerations to first rank and mandating their consideration in every case.

The clear implication of what the Court *did* say, consistent with *Graham's* conclusion that § 103 simply codified antecedent precedent from this Court expressing a patentability standard which "has remained invariable", is that secondary considerations are of *inferior* impor-

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in exactly the same way as it did in the prior art" (Brief at 27). The Court's opinion specifically includes a finding that "Here, however, the Adams battery is shown to embrace elements having an *interdependent functional relationship*" (383 U.S. at 50; Emphasis Added). Moreover, it is apparent from reading the Opinion *in context* that the Court concluded that the Adams battery had been assembled in contravention of, rather than in strict conformity with, the existing state of knowledge in the art—hence that the elements did *not* each perform their known functions. In addition, the Court held "the fact that the Adams battery is water-activated sets his device apart from the prior art", 383 U.S. at 48, which allegedly did not refer to water-activated batteries.

tance to the "basic inquiries" and *may* be resorted to *only to the limited extent and for the limited purpose* permitted by antecedent case law from this Court and hence *cannot* be considered unless the answers to the three "basic inquiries" leave room for doubt as to patentability.

A fundamental reason for this approach is that alleged inventions differing immaterially from the prior art and achievable at the level of minimal or no skill in the art—hence "obvious" under § 103—are often commercially successful or can be subjectively demonstrated through clever witness selection and preparation, to satisfy long-felt commercial "needs" or to astound putative experts.[19] It is accordingly of the highest importance that first the Patent Office and secondly the courts, satisfy themselves in each case that the alleged invention is more than a stratagem for creating a private monopoly in existing knowledge, thereby depriving skilled artisans of access to well known elements, *prior* to risking the often unreliable or misleading influence that "secondary consideration" evidence may exert.

As this Court said with specific reference to commercial success in *McClain* v. *Ortmayer*, 141 U.S. 419, 428 (1890):

> ". . . If the generality of sales were made the test of patentability, it would result that a person by securing a patent upon some trifling variation from previously known methods might, by energy in pushing sales or by superiority in finishing or decorating his goods, drive competitors out of the market and secure a practical monopoly without in fact having made the slightest contribution to the useful arts . . . ."

[19] Note the Fifth Circuit's tribute (Pet. 15a) in *this* case to Respondent's "skillfully" designed evidentiary presentation. See also, e.g. the examples of this "skillfully" designed evidence quoted in Respondent's Brief at 16-19.

Numerous pre-1952 decisions of this Court invoked the same rationale to assign to one or more of the "secondary considerations" a markedly inferior importance in assessing patentability and to emphasize that "secondary consideration" evidence may be received, if at all, only in doubtful cases. Examples include *Hotchkiss* itself, *Reckendorfer* v. *Faber*, 92 U.S. 347 (1876), *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U.S. 464 (1935), *Dow Chemical Co.* vs. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320 (1945); *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327 (1945); *Mandel Bros.* v. *Wallace*, 335 U.S. 291 (1948); *Jungersen* v. *Ostby and Barton Co.*, 335 U.S. 560 (1949) and *A & P*, *supra*. *Graham*, in context, simply reemphasized this principle.

Subsequent to *Graham*, *Black Rock* quoted from *A & P* to emphasize again that ". . . long-felt want . . . and commercial success . . . 'without invention will not make patentability.'" 396 U.S. at 61.

The lower federal courts, including two of the circuits noted by the D. C. patent lawyer amici as "'not inhospitable to patents'" (Motion p. 3a), the Sixth and Seventh Circuits, have generally had no difficulty in understanding that *Graham* and *Black Rock* preserved a pre-existing state of law to assign *inferior* importance to "secondary consideration" evidence and to preclude its consideration except in genuinely doubtful cases. See, e.g.,—*Vanity Fair Mills, Inc.* vs. *Olga Co.*, 510 F.2d 336, 338-340 (2nd Cir. 1975);[20] *Hadco Products, Inc.* vs.

[20] The seemingly inconsistent dicta in *Timely Products* vs. *Arron*, 523 F.2d 288 (2nd Cir. 1975) quoted in D.C. Bar Brief at 33, must be understood in the context of the facts that (a) *Timely* was written for the Second Circuit by the only district judge in the United States who was a patent lawyer before appointment to the bench and (b) notwithstanding § 103's express direction that obviousness is to be assessed as of "the time the invention was made", *not later*, the Second Circuit occasionally strays into error traceable

Walter Kidde & Co., 462 F.2d 1265, 1276 (3rd Cir. 1972); *Blohm & Voss AG* v. *Prudential Grace Lines, Inc.*, 489 F.2d 231, 243 (4th Cir. 1973); *Skega Aktiebolag* v. *B. F. Goodrich Co.*, 420 F.2d 1358, 1360 (6th Cir. 1970); *Speakman Co.* vs. *Water Saver Faucet Co.*, 497 F.2d 410, 411 (7th Cir. 1974); *Hewlett-Packard Co.* vs. *Tel-Design, Inc.*, 460 F.2d 625, 630-1 (9th Cir. 1972).

A different state of affairs exists in the CCPA, however—and it is that Court's aberrant approach which the D.C. patent lawyers now urge this Court to adopt (Brief at 32). The evolution of that Court's present approach to secondary considerations affords considerable insight into the Patent Office's increased proclivity for granting ever more patents on alleged inventions of ever less technological importance and hence merits attention from this Court.

Prior to *Graham*, the CCPA recognized the inferior importance and *limited* relevance of "secondary considerations" evidence on patentability questions. *Application of Cline*, 345 F.2d 847, 850 (CCPA 1965); *Application of Jones*, 298 F.2d 944, 946 (CCPA 1962). In 1966 after *Graham* was decided, the CCPA com-

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to erroneous patent decisions promulgated by the late Judge L. Hand, e.g., in *Safety Car Heating and Lighting Co.* vs. *General Electric Co.*, 155 F.2d 927, 939 (2nd Cir. 1946) quoted in D.C. Bar Brief at 29-30. Judge Hand, albeit an able jurist in many areas, has expressed opposition to the constitutional standard of invention as delineated in this Court's opinions and generally devoted himself, in adjudicating patentability questions, to looking for ways to avoid coping with technology *per se*. See, e.g. *Parke-Davis & Co.* vs. *H. K. Mulford Co.*, 189 F. 95, 115 (CCSDNY 1911) wherein even as a district judge, he placed great weight on such secondary considerations as the opinions of experts in the field and added "I cannot stop without calling attention to the extraordinary condition of law which makes it possible for a man without even the rudiments of chemistry to pass upon such questions as these" involving the validity of certain pharmacological product patents. See also *Safety Car, supra*, 155 F.2d at 939 and cases cited, *Reiner* vs. *I. Leon Co.*, 285 F.2d 501, 504 (2nd Cir. 1960).

menced to shift position on "secondary consideration" evidence, using the same distortion of its language that is urged here as the pretext for holding that such evidence should be admitted *even* if no doubt as to patentability existed. See *Application of Sherman*, 361 F.2d 1008, 1012 (CCPA 1966). The trend metamorphosed through such cases as *Application of Caveney*, 386 F.2d 917 (CCPA 1967); *Application of Warner*, 397 F.2d 1011, 1017 (CCPA 1967), *Application of Sponnoble*, 405 F.2d 578, 587 (CCPA 1969); *Application of Tiffin*, 443 F.2d 394, 398-399 (CCPA 1971), modified on other grounds, 448 F.2d 791 (CCPA 1971); *Application of McLaughlin*, 443 F.2d 1392, 1395-1396 (CCPA 1971); *Application of Palmer*, 451 F.2d 1100, 1102-1104 (CCPA 1971); *Application of Mageli*, 470 F.2d 1380, 1382-1383 (CCPA 1973); *Application of Fielder*, 471 F.2d 640, 643-646 (CCPA 1973) and *Application of Felton*, 484 F.2d 495, 500-501 (CCPA 1973) to where the CCPA now insists that all "secondary consideration" evidence *must* be accorded weight and importance equal to or greater than that received on *Graham's* basic inquiries. In *Fielder*, for example, the CCPA expressly held that "If it was previously the law that commercial success is 'of no moment unless patentability is in doubt' [citing case], such a proposition no longer has validity." Also in *Fielder*, it declined to reconsider this position, at the urging of the Patent Office, in the light of *Black Rock*, and used *Graham* as the excuse for its refusal. According to the CCPA, commercial success is even a determinant, inferentially, of the level of skill in the art and hence may be used to *rebut* a *prima facie* showing of obviousness grounded on the insignificance of the differences between the alleged invention and the prior art. See, e.g., *Felton, supra.*

As a *de facto* matter, this CCPA treatment of "secondary considerations" evidence has substituted for the "rule of doubt", *Application of Hofstetter*, 362 F.2d 293

(CCPA 1966), *cert.* granted *sub. nom. Brenner* vs. *Hofstetter*, 386 U.S. 990 (1967); vacated 389 U.S. 5 (1967), appeal dismissed 55 CCPA 1493 (1967), in that Court and the Patent Office and encouraged increased proliferation of doubtful patent grants. *Hofstetter* explained the reasons for the "rule of doubt" as follows:

> "Several of the factors properly taken into account in determining patentability, especially obviousness and utility, are often not known at the time when the application is being prosecuted in the Patent Office, but are developed later, perhaps even after the patent is issued. It therefore is proper that doubt should be resolved in favor of applicants so that they shall not be denied patents which later events may show them entitled to. Among such events, which may even have to await patenting, are commercial success, unexpected utility, displacement of competing devices, etc."

The CCPA allegedly has not applied the rule since *Hofstetter, Application of Naber*, 503 F.2d 1059, 1060 (CCPA 1974), and the Patent Office purportedly abandoned it formally about the same time. Mandatory consideration of "secondary" evidence on the issue of patentability, however, leads to essentially the same result for essentially the same reasons.[21]

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[21] The CCPA is now engaged in proselytizing judges in other courts to adopt a stance similar to its own on "secondary considerations." Its chief judge recently told a judges' gathering that:

> ". . . But these considerations are not secondary in *importance*, they are secondary only in time because they occurred or became relevant only after the invention was made. Just as you test many acts in other cases by what happened afterwards, it is proper and important and necessary to consider commercial success, copying by others, licenses, filling of a long-felt need and similar events in patent cases. The nexus between these features of the invention environment may be weak or strong. The weight you will attach to them will vary accordingly. But these indicia should be considered before, not after, you decide the question of obviousness. There is no warrant for disregarding any probative evidence in any case, patent cases included." *Markey*, Special Problems in Patent Cases, 57 J. Pat. Off. Soc'y 675, 684 (1975).

It is passing strange that the D.C. patent lawyers and the CCPA should abjure hindsight in evaluating prior art evidence relevant to patentability while insisting as they do, that hindsight and after-the-fact occurrences are of superior probity to overcome the effect of such evidence.[22]

Equally strange is their bemoaning of "divergence . . . in the standards of patentability" in face of the circumstance, clearly shown by the apposite cases decided since *Graham* that the major sources of divergence are the CCPA and the Patent Office. If the heresies they have espoused are corrected *now*, there *will be* a uniform body of law under 35 U.S.C. § 103.

CONCLUSION

Respondent's combination patent entitled "Dairy Establishment" is not novel, and does not meet the test of being nonobvious under 35 U.S.C. § 103 to a person having ordinary skill in the art to which the subject matter of the patent pertains. Because "Dairy Establishment" does not satisfy either the Constitutional test of Article I, Sec. 8, Cl. 8 or the statutory test of patentability within 35 U.S.C. § 101, 102 and 103, any other descriptive terminology that may be used to describe the effect or quality of the patent, such as "synergistic effect" is legally immaterial upon which to base patent validity. The Opinion of the Court of Appeals for the Fifth Circuit which predicated patent validity did so on a basis that was not lim-

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[22] Judge Rich, author of the D.C. Bar's Appendix A, states at 14a,

> "I suggest that in thinking about those [secondary] considerations, they be looked upon for what they factually are, circumstantial evidence of unobviousness of the highest probative value . . ."

ited by the statutory language set forth in 35 U.S.C. § 101, 102 and 103. Because the correct standard for determining patent validity was not followed, the Fifth Circuit Judgment upholding validity must be reversed. This Honorable Court can review the question of validity as a question of law, and render Judgment in favor of Petitioner.

The trial court finding to the effect that this combination did not show invention, did not meet the test of non-obviousness when viewed by the standard prescribed by 35 U.S.C. § 103, and the further finding that Petitioner was entitled to a new trial because of newly discovered evidence, the evidence introduced being sufficient to rebut any presumption of validity of the patent, when viewed against the standard prescribed by Rule 52 F.R.C.P., are entitled to be affirmed and upheld because they are supported by credible evidence of record, are not clearly erroneous and were reached by proper application of law to facts.

WHEREFORE, PREMISES CONSIDERED, Petitioner respectfully prays that this Honorable Court answer each of the questions submitted in the affirmative, that the Court invalidate the combination patent entitled "Dairy Establishment", that the complained of Judgments from the Court of Appeals, Fifth Circuit, be in all things reversed and rendered in favor of Petitioner, that Petitioner recover all of his costs and expenses incurred by said appeals, and that he have such other and

further relief to which under the law he is justly entitled.

Respectfully submitted,

SCOTT, HULSE, MARSHALL & FEUILLE
11-D El Paso National Bank Bldg.
El Paso, Texas 79901

JAMES F. HULSE

STEPHEN B. TATEM, JR.

Attorneys for Petitioner

CERTIFICATE

I hereby certify that a copy of the above and foregoing Reply Brief has this day been served upon opposing counsel of record by placing same in the United States Mail, postage prepaid and properly addressed on this the —— day of ————————, 1976.